6/13/02

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Paper No. 24
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

In re LTJ DIFFUSION

_____

Serial No. 75/288,084

_____

Anthony Mercaldi and Lori M. Stockton of Blakely Sokoloff Taylor & Zafman for LTJ DIFFUSION.

Mary Rossman, Trademark Examining Attorney, Law Office 109 (Ronald Sussman, Managing Attorney).

_____

Before Quinn, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

LTJ DIFFUSION has filed an application to register the

mark "ARTHUR" and design, as reproduced below,

for "clothing for men, women and children, namely, T-shirts, panties, long johns, bathing suits, underpants, shorts, socks, sweatshirts, sweatpants, sweat shorts, sweat suits, pajamas, sleep suits, bathrobes, dressing gowns, night-gowns, night shirts, night-dresses, overalls, jackets, over garments, namely, raincoats and overcoats; brassieres, shirts, old style shirts, robes, pyjashorts, track suits, slippers; underwear for babies."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its goods, so resembles the mark "ARTHUR," which is registered by the same registrant for (i) "clothing, namely, plush slippers; knit slipper socks; vinyl and/or patent leather dress shoes; suede, ultrasuede, leather-like and/or canvas casual shoes; vinyl rainboots; lace-up hiking boots with rubber soles; vinyl and/or plastic sandals; cotton knit socks (adult and children); embroidered woven cotton baseball caps; silk-screened printed tee shirts (adult and children); pajamas, footed pajamas"[2] and

[1] Ser. No. 75/288,084, filed on May 7, 1997, which is based on both an allegation of a bona fide intention to use such mark in commerce and ownership of French Reg. No. 17731, issued as of June 16, 1983 with renewal expiring as of June 16, 2003.

[2] Reg. No. 2,151,491, issued on April 14, 1998, which sets forth a date of first use anywhere and first use in commerce of May 1, 1997.

(ii) "clothing, namely, sweatshirts (adult and children),"[3] as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.[4]

Turning first to consideration of the respective goods, applicant maintains in its initial brief that the channels of trade for such goods differ so significantly that there is no likelihood of confusion. Specifically, applicant asserts that, "in light of the fact that goods bearing the Registrant's mark will be promoted in association with the cartoon character, ARTHUR THE AARDVARK, goods bearing the

[3] Reg. No. 2,168,166, issued on June 23, 1998, which sets forth a date of first use anywhere and first use in commerce of August 1998.

Registrant's mark are [thus going to be] marketed towards children that are fans of the Registrant's cartoon character, ARTHUR THE AARDVARK, such that the respective channels of trade of goods bearing the respective marks should not be considered to be related, and therefore, consumers are not likely to confuse the marks as to source, affiliation or sponsorship."

Applicant, in this regard, contends that "the evidence of record establishes a clear connection between the Registrant's ARTHUR mark, and the cartoon character, ARTHUR THE AARDVARK," inasmuch as registrant is shown to be the originator and author/illustrator of such. In particular, applicant notes that it has "submitted credible and uncontradicted evidence that the Registrant's mark is recognized, marketed and promoted in connection with the cartoon character, ARTHUR THE AARDVARK," including copies of "the ARTHUR THE AARDVARK cartoon character web page (excerpted from *www.pbs.org*), ... an on-line reference to the Registrant's shirt sales" and copies of companion registrations by registrant for the mark "ARTHUR" in which the goods are identified as "children's storybooks about an aardvark" and "computer software on CD ROMS and audio tapes featuring children's stories about an aardvark."

---

[4] The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

The issue of likelihood of confusion is determined, however, on the basis of the goods as identified in the respective application and cited registration(s), regardless of what the record may reveal as to the particular nature of those goods, their actual channels of trade, or the class of purchasers to which they are in fact directed and sold. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). That is to say, it is well settled in this regard that absent any specific limitations or restrictions in the identifications of goods as listed in the applicant's application and the registrant's registration(s), the issue of likelihood of confusion must be determined in light of consideration of all normal and usual channels of trade and methods of distribution for the respective goods and on the basis of all customary consumers therefor. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, the Examining Attorney correctly points out in her brief that, as identified in the application and cited

registrations, the "respective goods are closely related, complementary and in some instances identical," with the latter encompassing T-shirts (or tee shirts), socks, sweatshirts, pajamas (or pyjashorts) and slippers. Moreover, the Examining Attorney properly observes that "[t]he identifications of goods in the cited registrations include none of the limitations that applicant posits -- the goods are not limited to children's clothing ..., there is no limitation indicating that the goods depict an aardvark character, there is no limitation as to whom the goods may be marketed, and there is no limitation that the channels of trade be associated with an aardvark character." In consequence thereof, the goods at issue would not only be marketed to the same classes of purchasers, including adults as well as children, but as the Examining Attorney persuasively indicates:

> As to marketing and channels of trade, it is well-known that after listening to children's requests, parents, grandparents and other relatives and family friends frequently look for and purchase items of clothing for children. .... Just as adults shopping for children in department, discount and specialty stores find Mickey, Daffy and Pooh clothing sold in the same sections and on the same racks ...[or] shelves as other brands, they may look for and find registrant's and applicant's clothing in the same sections and on the same racks and shelves.

Accordingly, because both applicant's goods and those of registrant are identified, without limitation or restriction, as various items of "clothing" for adults and children, they must be presumed to encompasses all types of the specified apparel and to be suitable for sale through all normal and usual trade channels and distribution methods therefor.[5] See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). In so basing our approach to the issue of whether there is a likelihood of confusion on consideration of the entire marketplace for the respective goods, we note that as stated in Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, supra at 1 USPQ2d 1816, such "is precisely the approach" which is required and that "nothing in *du Pont* ... is inconsistent with it." Consequently, inasmuch as the respective goods must be treated as legally identical, complementary and otherwise closely related articles of clothing which would be offered through the identical or substantially similar channels of trade to the same classes of consumers, it is clear that if such goods were to be

[5] Given the identity in the trade channels and distribution methods for the goods at issue herein, the request in applicant's initial brief that "the Board ... consider In re Shipp, 4 USPQ2d 1174 (TTAB 1987)[,] wherein the Board determined that [due to differences in the channels of trade and classes of purchasers the mark] PURITAN was not likely to cause confusion for dry cleaning and laundry services with the identical word mark and word and design mark for a variety of dry cleaning and cleaning preparations" is inapposite.

marketed under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Turning, therefore, to consideration of the respective marks, applicant raises two primary arguments. First, applicant asserts that "the Registrant's mark is diluted and weak, and therefore, not worthy of a broad scope of protection." Second, applicant maintains that, "given the manner in which the Registrant's mark will be associated with the cartoon character, ARTHUR THE AARDVARK, consumers would not likely perceive the Applicant's stylized depiction of the ARTHUR mark and the Registrant's mark as having confusingly similar commercial impressions."

In support of its first argument, applicant has made of record copies of several "third-party registrations wherein the term ARTHUR appears as part of a registered trademark in connection with goods in the field of apparel." Such registrations include the marks: "ARTHUR MAX" (in a script design) for "tops, skirts, dresses, jumpsuits and jackets";[6] "AWFUL ARTHUR'S" and design for "headwear and shirts"; "ARTHUR ET FELICIE" for "wearing apparel for women and children, namely, shirts, pants, sweaters, socks, jackets, dresses, coats, hats, scarves, gloves, underwear, shoes and slippers"; "EVELYN &

ARTHUR" for "clothing, namely--dresses, suits, skirts, blazers, shirts, blouses, camisoles, sweaters, slacks, jeans, overalls, sweatpants, sweatshirts, shorts, culottes, swimwear, bathing suits, bathrobes, tennis wear, belts, caftans, capes, rain coats, stockings, socks, footwear, caps, hats and headbands"; "ARTHUR WINER" for "clothing for men and women, namely, pants, shirts, blouses, jackets, dresses, skirts and vests"; and "ROBERT ARTHUR" (in a script design) for "women's clothing--namely, jackets, skirts, slacks, blouses, sweaters and dresses."[7] While acknowledging that "third-party registrations are not dispositive in any given case," applicant insists that "the above registrations containing the term ARTHUR for use upon clothing present a convincing picture of the extent to which the [cited] Registrant's mark is entitled to [but] a limited scope of protection when used in connection with apparel."

However, as the Examining Attorney correctly points out in her brief, "[t]hird-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks." See, e.g., National

[6] Such registration, although initially cited by the Examining Attorney as an additional bar to registration by applicant of its mark, was subsequently withdrawn as a bar under Section 2(d) of the statute.
[7] In addition, applicant made of record a copy of a third-party registration for the mark "ARTHUR'S TROUSERS" (with the word "TROUSERS" disclaimed) for "trousers." Although such registration, unlike the ones above, has expired for failure to file a renewal, applicant maintains that the registration was still subsisting at the time the two registrations cited herein issued.

Aeronautics & Space Administration v. Record Chemical Co., 185 USPQ 563, 567 (TTAB 1975). Such registrations, she further properly notes, "are not evidence to show that the marks are actually being used, or that the extent of third party use is so great that customers have become accustomed to seeing these marks and hence have learned to distinguish them." See, e.g., Smith Brothers Manufacturing Co. v. Stone Manufacturing Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983). Consequently, and as likewise indicated in AMF Incorporated v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973), the co-existence of the third-party registrations with the cited registrations does not justify registration of yet another confusing mark inasmuch as:

> [L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registration is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

Moreover, to the extent that applicant may also mean to utilize the copies of the third-party registrations in a manner analogous to a dictionary or other standardized reference

work, so as to show that the term "ARTHUR" has both a given name and a surname significance and thus has been adopted by various third parties as part of their marks for that reason (i.e., as the given name or surname of real or fictitious fashion designers or other individuals), it is obvious that the marks at issue herein consist of the term "ARTHUR" without any other significantly distinguishing element(s). While we note that applicant's stylized "ARTHUR" mark includes a small dot or ink spot in addition to the script presentation of the letters comprising such term, the dot or spot is simply too insufficient an element to differentiate applicant's mark from the cited registrant's "ARTHUR" mark. This is because the latter, being in typed form, encompasses the display of the term "ARTHUR in any reasonable manner, including the same stylized script lettering as utilized by applicant in its "ARTHUR" and design mark. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) and INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992). Accordingly, not only are the marks at issue identical in sound and connotation, but they must also be regarded as virtually identical in appearance. Consequently, when considered in their entireties, applicant's "ARTHUR" and design mark and the cited registrant's "ARTHUR" mark project essentially the same commercial impression.

Applicant, however, takes issue with such conclusion, raising as its remaining primary argument that the overall commercial impression engendered by each of the marks at issue is not likely to be "confusingly similar" because, as stated previously, "the Registrant's mark will be associated with the cartoon character, ARTHUR THE AARDVARK ...." While we disagree with the Examining Attorney's contention that applicant's attempt to limit or restrict the scope of protection of registrant's mark in such a manner "constitute[s] a collateral attack on a cited registration" and hence is impermissible, suffice it to say that the issue of likelihood of confusion, insofar as the registrability of applicant's mark is concerned, is determined on the basis of such mark and registrant's mark as they are respectively set forth in the application and cited registrations. This is because Section 2(d) of the Trademark Act precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion ...." Thus, the fact that registrant presently uses its "ARTHUR" mark on its website and, presumably, on labels or packaging for its apparel, with such additional matter as its "ARTHUR THE AARDVARK" cartoon character is irrelevant and immaterial to the issue of likelihood of confusion. See, e.g., Sealy, Inc. v. Simmons Co., 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); Burton-Dixie Corp. v. Restonic

Corp., 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); Hat Corp. of America v. John B. Stetson Co., 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and ITT Canteen Corp. v. Haven Homes Inc., 174 USPQ 539, 540 (TTAB 1972).

Accordingly, we conclude that purchasers and potential customers, who are familiar or acquainted with registrant's "ARTHUR" mark for its various items of clothing, would be likely to believe, upon encountering applicant's virtually identical "ARTHUR" and design mark for its articles of clothing, that such in part legally identical, complementary and otherwise closely related items and articles of apparel emanate from, or are sponsored by or associated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.